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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86170852
Applicant	GREE, Inc.
Applied for Mark	GREE
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Date	12/31/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Trademark Application of     )  
Gree, Inc.                                 )  
   )  
Serial No: 86/170,852                 )  
   )  
Filed: January 21, 2014               )  
   )  
Trademark: GREE                        )  
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Law Office 102

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**APPLICANT’S REPLY BRIEF**

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Applicant GREE, Inc. (“Applicant”) hereby respectfully submits this reply brief in support of its appeal from the Examining Attorney’s refusal to register Applicant’s GREE mark (“Applicant’s Mark,” the “Mark” or the “GREE Mark”) appearing in U.S. App. No. 86/170,852 (the “Application”). Accordingly, this Brief is submitted in support of registration of Applicant’s Mark.

## **I. INTRODUCTION**

This brief responds to the Examining Attorney’s Appeal Brief submitted on December 11, 2015 (the “Examiner’s Brief”). Specifically, Applicant seeks to address the following points: (1) the Examining Attorney’s statements regarding Applicant’s companion application (U.S. Serial No. 85/422,099); (2) the Examining Attorney’s reliance on third-party registrations to show that the services at issue are of a type that may emanate from a single source; and (3) the objections raised by the Examining Attorney regarding Applicant’s amendments to the recitation of services covered under Applicant’s mark.

The Examining Attorney alleges that, under Section 2(d) of the Trademark Act, Applicant’s Mark is allegedly likely to cause confusion with U.S. Registration No. 4362969 (the “Cited Registration”) for the mark G GREE & Design (the “Cited Mark”), owned by Gree Electric Appliances, Inc. of Zhuhai (“Registrant” or “ZG”). The Examining Attorney has based this assertion on the fact that the mark in the Cited Registration is used in connection with “radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer

network; teleconferencing services; providing user access to a global computer network; voice mail services” (the “Cited Services”).

Applicant presented evidence that Applicant’s services are distinguishable from the Cited Services. Applicant also presented evidence that the USPTO had previously found there to be no likelihood of confusion between U.S. App. No. 85/422,099, also owned by Applicant (the “Companion Application”), for the mark GREE & Design (the “Companion Mark”) and the Cited Registration. The recitation of services appearing in the Companion Application includes services in Class 38 that are essentially identical to the services appearing in the present Application, as amended herein. Notably, the filing date of the Companion Application is September 14, 2011, while the filing date of the Cited Registration is May 2, 2012.

In summary, for the reasons set forth in its appeal brief of October 11, 2015 and in the present reply brief, Applicant respectfully asserts that there is no likelihood of confusion in this case, and therefore the Section 2(d) refusal should be withdrawn and the Application should be approved for publication.

## **II. ARGUMENT**

### **a. The Effective Filing Date of the Cited Registration Post-Dates the Effective Filing Date of the Companion Application, and Should Not Serve as the Basis for Refusal of the Application**

The Examining Attorney has alleged that Applicant has misstated the present status of the Companion Application, U.S. App. No. 85/422,099, also owned by Applicant, for the mark GREE & Design, pictured below:



Importantly, the Companion Application's filing date is September 14, 2011. This predates the filing date of the Cited Registration, which was filed on May 2, 2012, by nearly eight months.

As noted in Applicant's appeal brief, at the time the appeal brief was filed on October 11, 2015, the Companion Application was suspended pending the submission of a certified copy of the foreign registration from applicant's country of origin. The Companion Application was filed under Section 1(b) of the Trademark Act on September 14, 2011. As of January 12, 2012, at the conclusion of *ex parte* examination, the Companion Application was approved for publication by the assigned examining attorney. On January 18, 2012, Applicant's counsel submitted a post-publication amendment to amend the basis of the Companion Application to add a 44(e) filing basis. On February 4, 2012, the assigned examining attorney completed the amendment by adding the 44(e) filing basis to the Companion Application, in addition to the 1(b) basis initially filed. On March 5, 2012, the Companion Application was suspended pending Applicant's submission of a copy of the foreign registration.

As previously noted in Applicant's Appeal Brief, the recitation of services appearing in the Companion Application includes services in Class 38 that are essentially identical to the services appearing in the present Application, namely:

*Providing on-line chat rooms and electronic bulletin boards for social networking; Providing on-line chat rooms and electronic bulletin boards for registered users for transmission of messages and photographs concerning*

*collegial life, general interest, social networking, social gaming and photo sharing*, in International Class 38.

Notwithstanding the fact that *ex parte* examination of the Companion Application had concluded and the Companion Application had been approved for registration, on December 15, 2015, the examining attorney responsible for the Companion Application (the “Companion Application Examiner”) issued an Office Action due to an alleged likelihood of confusion, with respect to Class 38, between the Companion Application and the Cited Registration. Presumably this Office Action was issued at the request of the Examining Attorney of the Application, as the Examining Attorney was apparently aware of the fact that the status of the Companion Application had changed when filing his Examiner’s Brief on December 11, 2015, notwithstanding the fact that the Office Action was not actually issued by the Companion Application Examiner until December 15, 2015.

In any case, the refusal of the Companion Application due to an alleged likelihood of confusion with the Cited Registration is wholly improper, given that the Companion Application has an earlier Effective Filing Date. *See 37 C.F.R. §2.83(a)*; TMEP §1208.01. Therefore, the refusal of the Companion Application cannot be used by the Examining Attorney to support the refusal of the Application here.

Applicant respectfully requests that the Board act consistently and withdraw the likelihood of confusion refusal on the basis that Applicant holds priority in the GREE mark for the relevant services in Class 38. A failure to do so would be to the prejudice of the Applicant in light of its prior rights in the GREE & Design mark in Class 38, as established by the existence of the Companion Application.

**b. The Examining Attorney Improperly Relies on Third-Party Registrations to**

### **Support the Likelihood of Confusion Refusal**

The Examining Attorney overemphasizes the importance of third-party registrations showing that a single entity has registered a single mark for services of the type identified in Applicant's amended identification of services and the services covered under the Cited Registration. While the Examining Attorney relies on the existence of third-party registrations covering services allegedly of the type covered under both the Application and the Cited Registration, the case law cited by the Examining Attorney on this point regarding the probative value of such registrations is equivocal at best.

Indeed, the Board has previously noted that third-party registrations “may have some probative value to the extent that they may serve to suggest that such goods or services are of a type that emanate from a single source.” *In Re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993) (emphasis added). The Board's position on this point is clear: while potentially probative, the existence of third-party registrations is by no means conclusive that the goods or services at issue are likely to be perceived by consumers as emanating from a single source.

While third-party registrations may serve to show that certain entities may offer the same or similar services under a single mark, such offering by unrelated entities does not and cannot serve to show that the Class 38 services covered under the Application and the Cited Registration are likely to cause confusion, where Applicant has explained in detail the highly-relevant factors that will serve to eliminate any possibility of consumer confusion in the present case. Here, as shown in the Record, Applicant and the owner of the Cited Registration offer distinguishable services, which consumers are and will be able to distinguish in the marketplace.



**c. Identification of Services**

The Examining Attorney has alleged that Applicant's amendment to the Class 38 recitation of services improperly expanded the scope of the recitation of services by adding "software applications and...deleting the fields of social networking and general interest." *See Brief of Examining Attorney*. Additionally, the Examining Attorney noted in the Examining Attorney's Brief that, "on-line chat rooms and electronic bulletin boards are provided through websites and not software applications." *Id.*

Contrary to the Examining Attorney's assertion, Applicant has not expanded the scope of Class 38 services covered under the Application. Likewise, Applicant has not deleted the wording "fields of social networking and general interest," but rather restructured the entire recitation of services to limit the scope of services, thereby eliminating any possibility of consumer confusion.

As noted in the Examining Attorney's Brief, in response dated October 22, 2014, Applicant submitted the following acceptable amendment to the recitation of services:

"providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest; electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network." (emphasis added)

The amendment submitted on October 22, 2014 consisted of two clauses separated by a semicolon. The first clause, "providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest," was limited by the wording "fields of social networking and general interest," while no such limitation applied to the second clause.

On May 13, 2015, Applicant submitted a request for reconsideration that included an

amendment of the recitation of services, consistent with Applicant's explanation of how consumers access the services, as follows:

Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest

In the May 13, 2015 amendment, Applicant restructured the entire recitation of services covered under the Application. While the prior recitation of services consisted of two independent clauses separated by a semicolon, the amended recitation of services is a single clause. The single clause recitation of services concludes with the wording "in the fields of social games, video games, and general interest." Therefore, because the amended recitation of services consisted of a single clause, this final wording serves to limit all of the preceding text, rather than just one of two clauses as in the October 22, 2015 amendment. Thus, in reality, the May 13, 2015 amendment is more limited than the October 22, 2014 amendment.

Moreover, the May 13, 2015 amendment cannot be interpreted to expand the scope of services by adding "software applications," as the Examining Attorney contends. To the contrary, the amended language limits the channels through which Applicant's services will be rendered. That is, the May 13, 2015 amendment makes clear that applicant's online chat rooms and electronic bulletin boards are offered through Applicant's proprietary social networking websites and Applicant's proprietary software applications. Thus, it is clear that Applicant's May 13, 2015 amendment only further limits the scope of services covered under the Application.

Applicant respectfully notes that the Examining Attorney's assertion that on-line chat rooms and electronic bulletin boards are only provided through websites and not through

software applications is wholly inaccurate. For example, brief searches of the iTunes App Store and Google Play disclosed myriad downloadable mobile software applications for “chat,” “messages,” and “bulletin board.” Attached as Exhibit A are true and correct screen shots of the search results for the foregoing terms, showing downloadable mobile software applications. Clearly the services recited in the Application can be, and frequently are, provided via software applications. Thus, while it would be inappropriate for Applicant to amend the Application to include software applications directly, it is not in appropriate for the Application to be amended to specify that the recited services will be offered via such software.

Finally, Applicant also notes that in the Examining Attorney’s Appeal Brief, the Examining Attorney has requested that the Board affirm the refusal of the amendment to the identification of services. In the paragraph immediately preceding the conclusion, the Examining Attorney states that:

“the identification of services should read as follows: providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest.”

Perplexingly, the amendment to the recitation of services that the Examining Attorney seeks to have affirmed by the Board is identical to the amendment submitted by Applicant on May 13, 2015. Accordingly, Applicant is uncertain as to why the Examining Attorney contends that the amendment should be refused, if the Examining Attorney is of the opinion that the final recitation of services should be identical to the amended recitation submitted by Applicant on May 13, 2015.

In light of the above, Applicant respectfully requests that the Board affirm the propriety

of Applicant's amendment to the recitation of services submitted on May 13, 2015.

### **III. CONCLUSION**

For the reasons set forth above, Applicant respectfully asserts that there is no likelihood of confusion in this case, and therefore the Section 2(d) refusal should be withdrawn.

Dated: Washington, District of Columbia  
December 31, 2015

Respectfully submitted,

DLA Piper LLP (US)  
*Attorneys for Applicant*

By: 

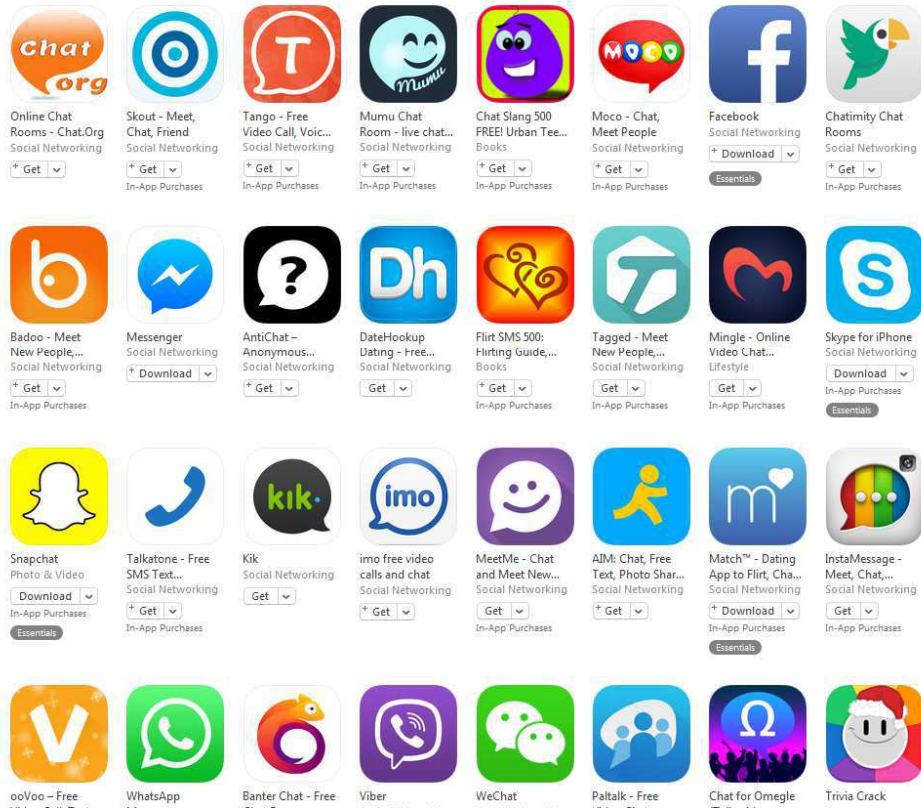
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## EXHIBIT A

### iTunes App Store

Showing results for "chat"

#### iPhone Apps



All

iPhone Apps

iPad Apps

Apps for Apple Watch

Albums

Songs

Podcasts

Books

Audiobooks

TV Shows

iTunes U

Movies

Music Videos

#### ARTISTS AND MORE

Chat >

Pop

HELLOTALK FOREIGN LANGUAGE

EXCHANGE LEARNING TALK CHAT

APP >

App Developer

SNAP DUB - Like Chat Save Upload Edit

Picture Video Gif Collage and Music

layout maker tube Inc. >

App Developer

Bindle Chat Inc. >

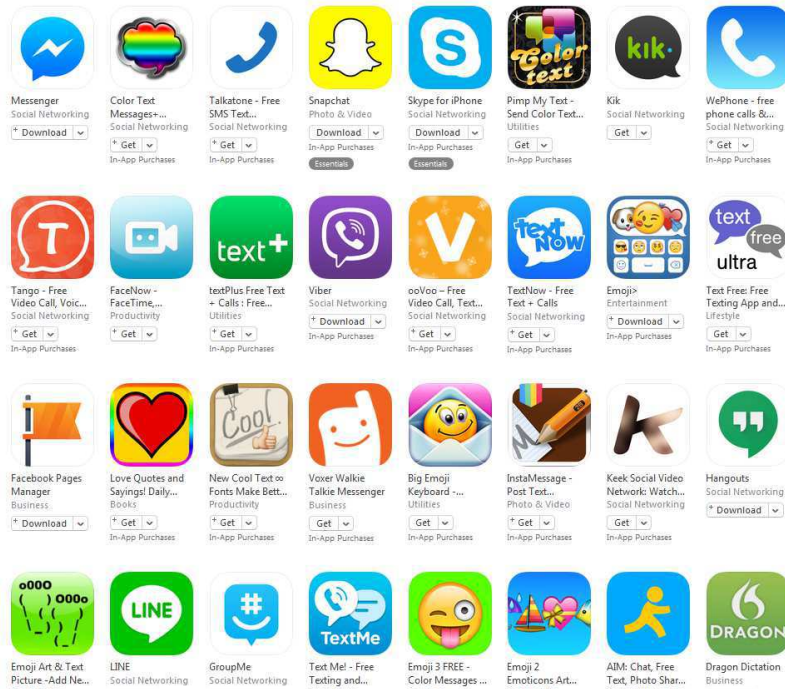
App Developer

Chat Sports >

App Developer

## Showing results for "messages"

### iPhone Apps



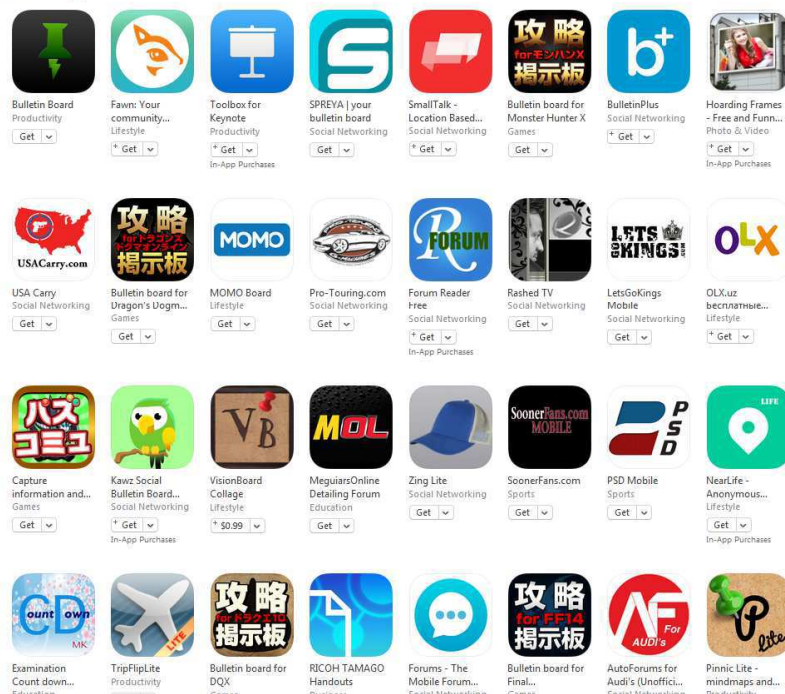
All  
 iPhone Apps  
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 Albums  
 Books  
 Audiobooks  
 Podcasts  
 TV Shows  
 Movies  
 Music Videos  
 iTunes U

### ARTISTS AND MORE

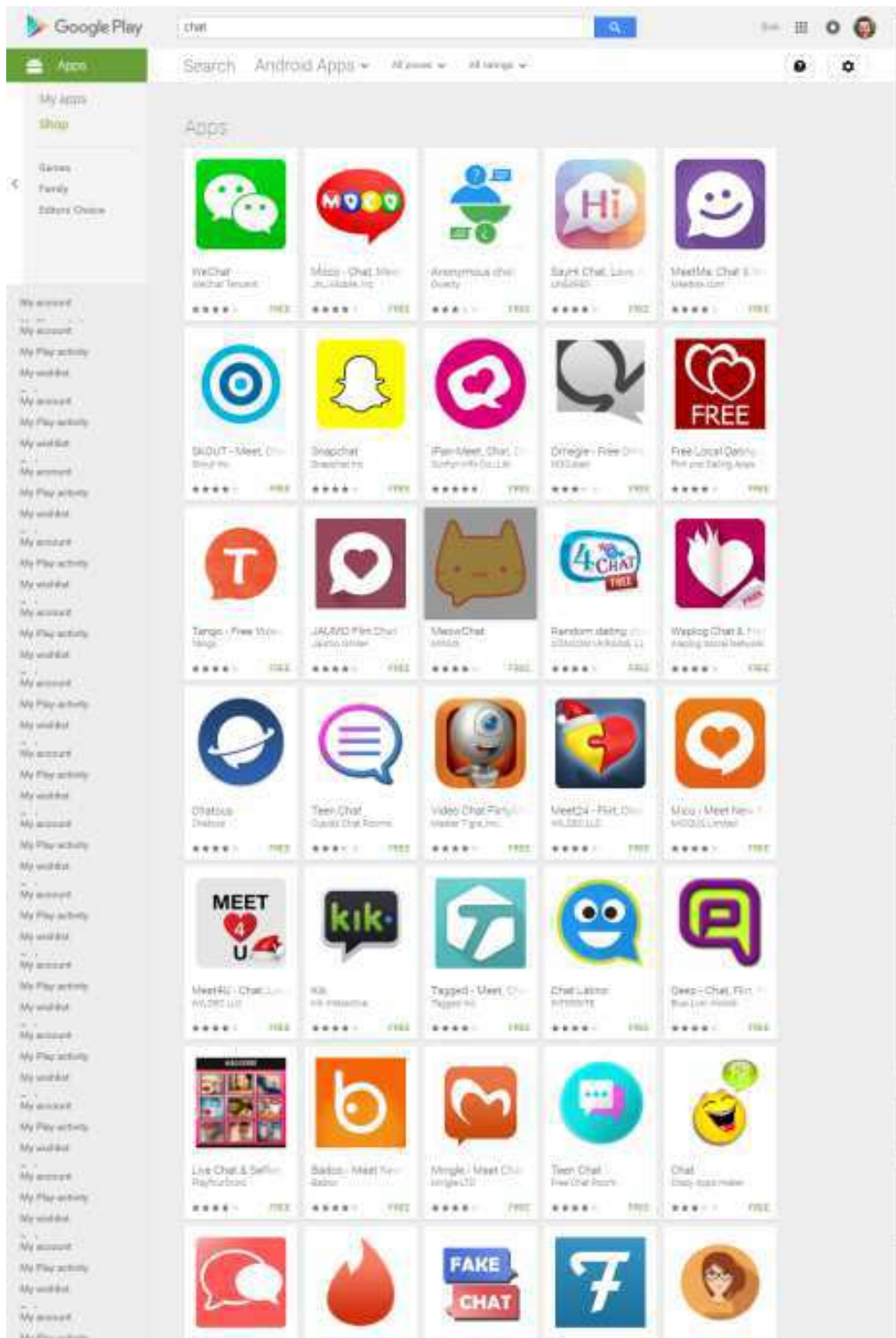
Messages >  
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## Showing results for "bulletin board"

### iPhone Apps



All  
 iPad Apps  
 iPhone Apps  
 Albums  
 Songs  
 Podcasts  
 iTunes U  
 Books



Google Play





